

Examiner is not persuaded by Applicant's arguments, Applicant respectfully requests that the Examiner enter the Amendment to clarify issues upon appeal.

In the above-identified Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,038,505 ("Probst"). The Examiner also rejected claims 3 and 5-10 under 35 U.S.C. § 103 as being unpatentable over Probst in view of U.S. Patent No. 6,098,005 ("Tsukamoto").

In the above-identified Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 102 as being anticipated by Probst. In addition, in response to Applicant's arguments, the Examiner stated that Probst discloses:

- learning whether performance of the automatic transmission *can be* improved utilizing the positioning data and the transmission data (column 7, lines 15-22);
- adjusting a shift threshold for the automatic transmission for the positioning data if it is determined before that the performance of the automatic transmission *can be* improved (column 7, lines 15-22).

Further, it has been held that the recitation that an element is "can be" [sic] perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a patentable limiting in any patentable sense.

Applicant respectfully disagrees with the Examiner's rejection. Claim 1 recites:

1. A method for controlling an automatic transmission comprising the steps of:
 - (a) obtaining positioning data using a global positioning satellite (GPS);
 - (b) monitoring the automatic transmission to obtain transmission data;
 - (c) learning whether performance of the automatic transmission can be improved utilizing the positioning data and the transmission data;
 - (d) adjusting a shift threshold for the automatic transmission for the positioning data if it is determined in step (c) that the performance of the automatic transmission can be improved and if the positioning data can be obtained using the GPS, and setting the shift threshold to a preset shift threshold if the positioning data cannot be obtained using the GPS.

Thus, claim 1 recites the steps of "obtaining positioning data", "monitoring the automatic transmission", "learning" and "adjusting a shift threshold" under certain circumstances.

Applicant respectfully submits that all of the steps recited in claim 1 are performed and,

therefore, are positive limitations. Claim 1 does not recite that steps can be performed. Instead, claim 1 recites that certain steps are performed if particular conditions are met. The term “can be” occurs in steps (c) and (d). Elements (c) and (d) recite positive steps that **are** performed. The term “can be” in step (c) modifies the phrase “performance of the automatic transmission”, not whether the step is performed. In step (c), the method uses positioning data and transmission data to learn about the performance of the automatic transmission. What is learned is whether it is possible to improve the performance of the automatic transmission. In other words, what is learned is whether the performance of the automatic transmission can be improved. Similarly, claim 1 recites in step (d) that the shift threshold for the automatic transmission is adjusted under certain conditions, not that the shift threshold can be adjusted. As in step (c) the term “can be” modifies the phrase “performance of the automatic transmission.” The particular condition which triggers adjustment of the shift threshold is that, in step (c), it is determined that improving the performance of the automatic transmission is possible. In other words, the condition is that performance of the automatic transmission can be improved. Consequently, claim 1 recites positive limitations in each element, not merely that steps “can be” performed.

Neither Probst nor Tsukamoto, separately or in combination, teaches or suggests the combination of steps recited in claim 1. Claim 1 recites in step (d) that the shift threshold is adjusted if it is determined in step (c) that the performance of the automatic transmission can be improved and if the positioning data can be obtained using the GPS. Step (d) further recites that the shift threshold is set to a preset shift threshold if the positioning data cannot be obtained using the GPS.

Probst is directed toward a system for controlling a transmission system based upon the surrounding environmental conditions. Probst, Abstract. Consequently, Probst describes a system

which utilizes data, including GPS data and data relating to the environmental pollution in order to control a transmission system. Probst, Abstract, col. 6, lines 19-20. Probst also discloses that the driver can reject this automatic method for controlling the transmission system. Probst, Abstract and col. 9, lines 50-53. However, Applicant can find no mention in Probst of adjusting the shift threshold if it is determined from GPS positioning data and automatic transmission data an improvement the performance of the automatic transmission is possible and, if GPS positioning data is unavailable, setting the shift threshold to a preset level. Consequently, Probst does not teach or suggest these features of the method recited in claim 1.

Tsukamoto describes a system that also controls the transmission of a vehicle based upon the vehicles surroundings, such as upcoming intersections. Tsukamoto, Abstract. However, like Probst, Applicant can find no mention in Tsukamoto of adjusting the shift threshold if it is determined, from GPS positioning data and automatic transmission data, that it is possible to improve the performance of the automatic transmission. Tsukamoto is also devoid of mention of setting the shift threshold to a preset level if the GPS positioning data cannot be obtained. Consequently, any combination of Probst and Tsukamoto also fails to teach or suggest these features. Accordingly, Applicant respectfully submits that claim 1 is allowable over the cited references.

The Examiner also rejected claims 3 and 5-10 under 35 U.S.C. § 103 as being unpatentable over Probst in view of Tsukamoto.

Applicant respectfully traverses the Examiner's rejection. Claims 3 and 5-10 depend upon claim 1. Accordingly, Applicant respectfully submits that claims 3-10 are allowable over the cited references.

Accordingly, for the above-mentioned reasons, Applicant respectfully submits that the claims are allowable over the cited reference. Consequently, Applicant respectfully requests

reconsideration and allowance of the claims as currently presented.

Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issue remain, the Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,

Janyce R. Mitchell
Sawyer Law Group LLP
Attorney for Applicant(s)
Reg. No. 40,095
(650) 493-4540